REMARKS

Disposition of Claims:

Claims 1, 2, 4-30 and 32-71 are all the claims pending in the application and have been rejected. Claims 44, 46 and 53 have been amended herein.

Claim Objections:

The specification is objected to as failing to provide proper antecedent basis for the subject matter of claim 44, namely the lower limit (30%) of the weight percent range of the gum base. The lower limit in claim 44 has been changed from 30% to 5% to be consistent with the specification.

Claim Rejections Under 35 U.S.C. §§ 102 and 103:

Claims 1, 2, 4, 12, 14-19, 23-30, 32,-34, 36, 37, 39-41, 43, 44 and 71 are rejected under 35 U.S.C. § 102(b) as being anticipated by Beringer, et al. (U.S. Patent No. 4,139,589). Claims 5-7, 13, 20-22, 35 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beringer, et al. Further, claims 8-10, 53, and 55-70 are rejected under 35 U.S.C. § 103 as being unpatentable over Beringer, et al. in view of Cherukuri, et al. (U.S. patent No. 4,753,805). Still further, claims 11, 38, and 45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beringer, et al. in view of Fisher, et al. (U.S. Patent No. 4,370,350). Finally, claims 46-52, and 54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beringer, et al. in view of Cherukuri, et al. and in further view of Fisher, et al. For the following reasons, Applicant respectfully traverses these rejections.

As an initial matter, Applicant thanks the Examiner for having withdrawn many of the previous objections and rejections have been withdrawn. However, Applicant respectfully believes that there may be some confusion on the Examiner part regarding the teachings of Beringer, and the contents of the pending independent claims. Thus, Applicant will try to explain the important distinctions between the two, below. Also, Applicant has requested an interview with the Examiner.

Beringer:

Beringer et al. is seen to be central to the Examiner's rejection of all claims. Applicant has previously in the response filed on August 8, 2008 commented on Beringer et al. and pointed out that there is no enabling disclosure in Beringer et al. and in particular no enabling disclosure of any actual chicle content of 60% as alleged by the Examiner. In the response of April 29, 2009 the Applicant pointed out that Beringer et al. has no disclosure of a tabletted chewing gum having a first part of particulated gum base material and separate particulated tablet base material, and a second part, compressed into a tablet. In the present Office Action the Examiner mentions that Beringer et al. in Example 2 discloses about 60% gum base.

In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." In re Hoeksema, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is

insufficient, if it cannot be produced without undue experimentation. Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). Applicant respectfully submits that Beringer et al. does not provide an enabling disclosure sufficient to anticipate the presently claimed invention, and for this reason, the rejections under 35 U.S.C. 102(b) cannot stand.

It is only when select, discrete portions of Beringer et al., which are related to completely different embodiments of the invention disclosed therein, are cherry-picked and cobbled together, that an anticipation rejection can even be asserted. This, of course, is improper, since it is impermissible for an Examiner to combine elements of separate and distinct embodiments disclosed in a reference to create an anticipation rejection. In this regard, the Examiner's attention is directed to, for example, In re Arkley, which is an early decision of the U.S. Court of Customs and Patent Appeals explicitly and unequivocally stating the one may not pick, choose and combine various disclosures in a reference not directly related to one another in order to fabricate an anticipation rejection. 455 F.2d 586, 172 USPQ 424, 526 (CCPA 1972) ("Thus, for the instant rejection under 35 U.S.C. 102(e) to have been proper, the Flynn reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.") (emphasis in original). This same proposition was recently repeated by the Court of Appeals for the Federal Circuit in Finisar Corp. v. DirecTV Group Inc., which again clearly stated that it is not enough for all claimed elements to be found within a single cited reference; rather they must also be "arranged

as in the claim." 532 F.3d 1323, 86 USPQ2d 1609, 1618 (Fed.Cir. 2008) ("To anticipate a claim, a single prior art reference must expressly or inherently disclose each claim limitation.... But disclosure of each element is not quite enough — this court has long held that '[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.' ") (emphasis in original).

This, in order for Beringer et al. to anticipate any of claims 1, 20, 25, 39, 46, and 53 (the independent claims), it must disclose, in an enabling manner, every element of claims 1, 20, 25, 39, 46, and 53 in a single embodiment, as opposed to merely disclosing, in various places relating to various embodiments, each of the required elements of claims 1, 20, 25, 39, 46, and 53. Applicant respectfully submits that Beringer et al. fails to do so.

More specifically, Beringer et al. discloses multiple embodiments relating to three general types of tablets: (1) multi-layer tablets having a plastic tablet mass formed from cutting a disc, or forming a ball, from a larger piece of plastic material, (2) multi-layer tablets having a plastic tablet mass formed from compressing plastic mass granules, and (3) multi-zone tablets formed by mixing together a plurality of different granule types and then compressing them into a single-layer tablet.

With respect to tablet type (1) relating to multi-layer tablets having a plastic tablet mass formed from cutting a disc, or forming a ball, from a larger piece of plastic material, this type of tablet is discussed in Beringer et al. with relation to the processes shown in Figures 7-9 and accompanying text, along with the description relating to Examples 1-5.

With respect to tablet type (3) relating to multi-zone tablets formed by mixing together a plurality of different granule types and then compressing them into a single-layer tablet, this type of tablet is discussed in Beringer et al. with relation to the process shown in Figure 11 and accompanying text, along with the description relating to Examples 6-12.

With respect to tablet type (2) relating to multi-layer tablets having a plastic tablet mass formed from compressing plastic mass granules, this type of tablet is discussed in Beringer et al. with relation to the process shown in Figure 10 and accompanying text; however, none of the Examples of Beringer et al. appear to relate to this type of tablet.

Turning now to the present invention as claimed, Applicant respectfully submits that tablet types (1) and (3) identified above are wholly immaterial to pending claims 1, 25, 39, 46, and 53, which require, *inter alia*, at least two integral parts or layers, of which a first integral part comprises a compressed mixture of particulated gum base material and separate particulated tablet base material, and of which a second integral part comprises a compressed particulated tablet base material. Applicant respectfully further submits that Beringer et al. is wholly immaterial to pending claim 20 on the process for the preparation of a tabletted chewing gum sweet in a configuration of two layers, requiring, *inter alia*, forming a first integral part of particulated gum base material and separate particulated tablet base material by mixing a particulated gum base material with a particulated tablet base material; forming a second integral part comprising a particulated tablet base material; and compressing both integral parts in the tablet press to enable the materials of each integral part to bind together and form a tabletted chewing gum sweet having the two integral parts joined together.

This is true because tablet type (1) includes no mixture of particulated gum base material and separate particulated tablet base material, and because tablet type (3) includes only a single part or layer, and because tablet type (2) includes no mixture of particulated gum base material and separate particulated tablet base material.

However, Applicant respectfully submits that there is no enabling disclosure of tablet type (2) or tablet type (3) that would anticipate 1, 25, 39, 46, and 53 of the present application. Again, it appears that the only portions of Beringer et al. that relate to tablet type (2) are Figure 10 and the corresponding text at Column 6, Line 30 – Column 7, Line 7. However, this extremely brief disclosure (the brevity of which is understandable given the fact that Beringer et al. greatly favors the embodiment of tablet type (1) where the plastic mass is cut from a larger slab of material) provides only a theoretical model of a process for making a multi-layer tablet having a plastic tablet mass formed from compressing plastic mass granules. No concrete examples are given, leaving one skilled in the art on his/her own. Applicant respectfully submits that such is not enabling, as choosing the appropriate materials, sizes, pressures, times, temperatures, etc. would involve a huge amount of creativity and experimentation.

Moreover, it should be noted that in addition to the above-discussed limitations, claims 1, 25, 39, 46, and 53 also require the combination of a layer or part of a compressed mixture of particulated gum base material and separate particulated tablet base material with a layer or part of a compressed particulated tablet base material, and it is this specific combination that results in the excellent crunch of the present invention.

As discussed above, it is not permitted for the Examiner to pick, choose and combine various disclosures in a reference not directly related to one another in order to fabricate an anticipation rejection. Beringer et al. is completely silent with respect to a multi-layer tablet where a layer of a compressed mixture of particulated gum base material and separate particulated tablet base material is combined with a layer of a compressed particulated tablet base material. As such, an anticipation rejection cannot be sustained.

Furthermore, Applicant respectfully submits that it would not have been obvious to have modified Beringer et al. to arrive at the present invention, as claimed. As discussed above, tablet type (2) is not enabled. Thus, in order to arrive at the present invention, as claimed, one skilled in the art would have to modify tablet type (1) or tablet type (3) in a way which would arrive at the present invention. However, it should be noted that, in formulating an obviousness rejection, the cited prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In the present case, when taken as a whole, it is clear that Beringer et al. suggests that tablet type (1) is preferred, namely that use of a pre-cut disc is to be preferred to compression processing of gum granules. As mentioned above, Beringer et al. in its general disclosure does mention both the possibility of using a disc cut from a strip of gum (Figure 7), and as an alternative the possibility to compress a layer from granulated plastic mass material (Figure 10). The conclusion in Beringer et al. is that it is better to use the cut-disc embodiment, which is perhaps why the inventors of Beringer et al. chose to exemplify this embodiment in preference to

the compressed gum embodiment. An explanation is given at the bottom of column 4, where it is stated that the use of a cut disc allows promotion of bonding between the upper and lower layers and the middle layer, and enables substantially lower pressures to be applied than would be necessary for bonding together three layers pressed from powder.

With these principles in mind, and given the statements in Beringer et al. which advocate the use of the cut-disc embodiment, and the absence of disclosure suggesting that advantageous effects would be associated with switching from the use of a cut-disc to a compressed gum layer (as found by the inventors of the present application), Applicant respectfully submits that the person skilled in the art would certainly have no motivation to make the required modification to move from the embodiments disclosed in the examples of Beringer et al. to the present invention. Applicant respectfully submits that, in fact, the person skilled in the art would have been led away from such a modification, and that the only reason to make the modification would be using hindsight in an attempt to formulate an obviousness rejection.

The Examiner has stated that there are no new or unexpected results. Applicant respectfully disagrees. As previously pointed out the Experimental Test Report HE4 shows the unexpected result of crunchiness. In Beringer et al. the gum base is plastic and not elastic, and the gum base layer in the example of a multi-layer tablet is of pure gum base. It is clear from the test report that a tablet of the kind disclosed in Beringer et al. cannot provide the desired crunchiness.

Accordingly, it is submitted that all claims patentably distinguish over the prior art.

Conclusion:

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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